Remarks

The Office Action mailed October 21, 2005 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-11 and 13-15 are now pending in this application. Claims 1-15 stand rejected. Claim 12 has been canceled.

In accordance with 37 C.F.R. 1.136(a), a three-month extension of time is submitted herewith to extend the due date of the response to the Office Action dated October 21, 2005, for the above-identified patent application from January 21, 2006, through and including April 21, 2006. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of $1,020.00 to cover this extension of time request also is submitted herewith.

The rejection of Claim 2 under 35 U.S.C. § 112, first paragraph, is respectfully traversed. Applicant respectfully submits that the specification meets the requirements of Section 112, first paragraph. The Office Action asserts at page 2 that Claim 2 recites the limitation "the submission of bordereaux" in line 2. Applicant respectfully traverses this assertion. However, in an effort to expedite prosecution of the present patent application, Applicant has amended Claim 2. Accordingly, Applicant respectfully requests that the rejection of Claim 2 under Section 112, first paragraph, be withdrawn. For the reasons set forth above, Applicant respectfully requests that the rejection of Claim 2 under Section 112, first paragraph, be withdrawn.

The rejection of Claims 1-11 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0143583 (Reader) in view of U.S. Patent No. 5,873,066 (Underwood) is respectfully traversed.

Applicant respectfully submits that neither Reader nor Underwood, considered alone or in combination, describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that neither Reader nor Underwood, considered alone or in combination, describe or suggest a process for a reinsurer to facilitate administration of a facultative automatic reinsurance agreement between a cedant and a

reinsurer using a computer system, wherein the process includes providing an automatic reinsurance agreement between the cedant and the reinsurer, wherein the automatic reinsurance agreement sets forth a reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under the reinsurance agreement without further underwriting by the reinsurer, nor a process including entering the reinsurance criteria into a database using the computer system. Rather, Reader describes displaying on a client's browser an underwriting page that includes a plurality of underwriting questions to be answered by the client for renewing a contract the client is authorized to access. Underwood does not make up for the deficiencies of Reader.

Reader describes an online reinsurance renewal method. The method includes providing a renewal web site that is accessible by a client and includes interactive web pages, which display policies or reinsurance contracts of the client and their status. The client selects a contract to renew and is transferred to an underwrite page which presents underwriting questions to determine if changes have occurred relative to the insured risk which would preclude automatic renewal. If no such changes are recorded, an authorization page is displayed including the terms for renewal. The client can electronically accept the terms by selecting a bind button. If changes to the insured risk are recorded, the client is prompted to electronically provide additional information to an underwriter to complete the underwriting process.

Underwood describes a computer-implemented system for managing the underwriting, quoting, and binding by an insurance company of an excess casualty insurance policy for an insured having a primary insurance policy with a primary insurance limit amount. The system selects and stores at least one standard industrial classification code ("SIC code") associated with the insured and a primary carrier name or multiple carriers associated with the primary insurance policy. A plurality of SIC code records corresponding to a plurality of SIC codes are stored in a database. Each of the SIC code records are linked to underwriting guidelines established and filed by the insurance carrier. These criteria include guidelines related to minimum premiums, hazard rating, underwriting authority, and referral criteria. Primary insurance carrier public bureau rating records are also stored in the database. Each of the primary insurance carrier public bureau rating records includes a field for storing a rating code representing a financial

stability rating associated with a primary insurance carrier. The system displays for the insurance carrier underwriter a plurality of candidate risk modifiers associated with the retrieved SIC code record, and for documenting and storing a selected risk modifier code and related underwriting criteria associated with the policy. The system develops the quotation using a detailed description of the insured's operation, the minimum premium amount information, the selected hazard code, the selected risk modifier code, primary insurance limits, and one or more attachment points.

Claim 1 recites a process for a reinsurer to facilitate administration of a facultative automatic reinsurance agreement between a cedant and a reinsurer using a computer system, wherein the process comprises the steps of "providing an automatic reinsurance agreement between said cedant and said reinsurer, said automatic reinsurance agreement setting forth a reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under said reinsurance agreement without further underwriting by said reinsurer...entering said reinsurance criteria into a database using said computer system...providing said cedant access to said database...instructing said cedant to enter into said database, terms for each insurance policy said cedant intends to submit for coverage under said automatic reinsurance agreement, wherein said cedant submits an initial report using said computer system including each policy submitted for coverage under said automatic reinsurance agreement...comparing said terms entered by said cedant for each insurance policy included on the initial report to said reinsurance criteria...and preventing any of said policies, for which said terms do not comply with said reinsurance criteria from being included on a final report to be submitted to said reinsurer for coverage under said reinsurance agreement."

Neither Reader nor Underwood, considered alone or in combination, describe or suggest a process as recited in Claim 1. For example, neither Reader nor Underwood, considered alone or in combination, describe or suggest a process including providing an automatic reinsurance agreement between a cedant and a reinsurer, wherein the automatic reinsurance agreement sets forth a reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under the reinsurance agreement without further

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underwriting by the reinsurer, nor a process including entering the reinsurance criteria into a database using a computer system. Rather, Reader describes displaying on a client's browser an underwriting page that includes a plurality of underwriting questions to be answered by the client for renewing a contract the client is authorized to access. As such, and for example, Reader does not describe nor suggest an automatic reinsurance agreement that sets forth reinsurance criteria for insurance policies to be automatically reinsured without further underwriting by a reinsurer. Underwood does not make up for the deficiencies of Reader. Because neither Reader nor Underwood describes or teaches one or more of the claimed elements of Claim 1, it follows that a combination of Reader and Underwood cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 1 is patentable over Reader in view of Underwood.

Claim 2 recites a process for a reinsurer to facilitate submitting bordereaux using a computer system, each bordereau including a listing of insurance policies to be covered under a facultative automatic reinsurance agreement, wherein the process comprises the steps of "entering into an automatic reinsurance agreement between a cedant and a reinsurer, said automatic reinsurance agreement establishing reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under said reinsurance agreement without further underwriting by said reinsurer...entering said reinsurance criteria into a database using said computer system...providing said cedant access to said database...instructing said cedant to enter into said database, terms for each insurance policy said cedant intends to submit for coverage on a bordereau under said automatic reinsurance agreement, wherein said cedant submits an initial bordereau using said computer system including each policy submitted for coverage under said automatic reinsurance agreement...comparing said terms entered by said cedant for each insurance policy included on the initial bordereau to said reinsurance criteria...if in said comparison step, said terms comply with said reinsurance criteria, permitting said policy to be incorporated by said system on a final bordereau...if in said comparison step, said terms do not comply with said reinsurance criteria, said computer system sending a message to said cedant noting the terms that do not comply with said reinsurance criteria and instructing said cedant to correct any errors in said terms entered in

said database or submit a request that said reinsurer cover said policy under said automatic reinsurance agreement despite the non-compliance of said terms with said reinsurance criteria."

Neither Reader nor Underwood, considered alone or in combination, describe or suggest a process as recited in Claim 2. For example, and as discussed above with respect to Claim 1, neither Reader nor Underwood, considered alone or in combination, describe or suggest a process including entering into an automatic reinsurance agreement between a cedant and a reinsurer, wherein the automatic reinsurance agreement establishes reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under said reinsurance agreement without further underwriting by the reinsurer, nor a process including entering the reinsurance criteria into a database using a computer system. Because neither Reader nor Underwood describes or teaches one or more of the claimed elements of Claim 2, it follows that a combination of Reader and Underwood cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 2 is patentable over Reader in view of Underwood.

Claim 3 depends from independent Claim 2. When the recitations of Claim 3 are considered in combination with the recitations of Claim 2, Applicant submits that dependent Claim 3, for at least this reason, is likewise patentable over Reader in view of Underwood.

Claim 4 recites a computer system for maintaining and administering a facultative automatic type reinsurance agreement between a cedant and a reinsurer and pursuant to which reinsurance is provided for individual insurance policies, wherein the computer system comprises "a server including a processor…a database connected to said processor for storing data…and a program executable on said processor…to collect reinsurance criteria established by said reinsurance agreement and store said reinsurance criteria in said database, said reinsurance agreement entered into between said cedant and said reinsurer setting forth said reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under said reinsurance agreement without further underwriting by said reinsurer…to collect insurance policy data including policy and ceding terms regarding each individual insurance policy for which coverage is sought by said cedant under said reinsurance

agreement and store said policy data in said database...to generate an initial report including each insurance policy for which coverage is sought by said cedant under said reinsurance agreement...to compare said policy and ceding terms for each insurance policy included on the initial report to said reinsurance criteria and determine if said policy and ceding terms comply with said reinsurance criteria...and to generate a final report including each insurance policy having policy and ceding terms that comply with said reinsurance criteria."

Neither Reader nor Underwood, considered alone or in combination, describe or suggest a computer system as recited in Claim 4. For example, and as discussed above with respect to Claims 1 and 2, neither Reader nor Underwood, considered alone or in combination, describe or suggest a computer system including a processor and a program executable on the processor to collect reinsurance criteria established by a reinsurance agreement and store the reinsurance criteria in a database, wherein the reinsurance agreement entered into between a cedant and a reinsurer setting forth the reinsurance criteria for insurance policies includes at least one of types of risks and classes of business to be automatically reinsured under the reinsurance agreement without further underwriting by the reinsurer. Because neither Reader nor Underwood describes or teaches one or more of the claimed elements of Claim 4, it follows that a combination of Reader and Underwood cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 4 is patentable over Reader in view of Underwood.

Claims 5-11 depend from independent Claim 4. When the recitations of Claims 5-11 are considered in combination with the recitations of Claim 4, Applicant submits that dependent Claims 5-11, for at least this reason, are likewise patentable over Reader in view of Underwood.

Claim 13 recites a process for preparing a bordereau for submission to a reinsurer using a computer system, said bordereau comprising a listing of individual insurance policies to be covered under a facultative automatic reinsurance agreement, said process comprising the steps of "providing an automatic reinsurance agreement between a cedant and said reinsurer, said automatic reinsurance agreement setting forth a reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured

under said reinsurance agreement without further underwriting by said reinsurer...storing said reinsurance criteria in a database coupled to said computer system...accessing said database using said computer system...entering into said database, policy and ceding terms for each insurance policy intended by said cedant to be included in said listing on said bordereau...causing the computer system to compare said policy and ceding terms entered into said database for each insurance policy to said reinsurance criteria to determine if said policy and ceding terms comply with said reinsurance criteria...and generating a bordereau using said computer system including a listing of each of said insurance policies in which said policy and ceding terms comply with said reinsurance criteria."

Neither Reader nor Underwood, considered alone or in combination, describe or suggest a process as recited in Claim 13. For example, and as discussed above with respect to Claims 1, 2, and 4, neither Reader nor Underwood, considered alone or in combination, describe or suggest a process including providing an automatic reinsurance agreement between a cedant and a reinsurer, wherein the automatic reinsurance agreement sets forth a reinsurance criteria for insurance policies including at least one of types of risks and classes of business to be automatically reinsured under the reinsurance agreement without further underwriting by the reinsurer, nor a process that includes storing the reinsurance criteria in a database coupled to a computer system. Because neither Reader nor Underwood describes or teaches one or more of the claimed elements of Claim 13, it follows that a combination of Reader and Underwood cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 13 is patentable over Reader in view of Underwood.

Claims 14 and 15 depend from independent Claim 13. When the recitations of Claims 14 and 15 are considered in combination with the recitations of Claim 13, Applicant submits that dependent Claims 14 and 15, for at least this reason, are likewise patentable over Reader in view of Underwood.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-11 and 13-15 as being unpatentable over Reader in view of Underwood be withdrawn.

In addition to the arguments set forth above, Applicant further submit that the rejection of Claims 1-11 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Reader in view of Underwood is further traversed on the grounds that the Section 103 rejection of the presently pending claims is not a proper rejection.

Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Reader using the teachings of Underwood. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Neither Reader nor Underwood, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Because there is no teaching, suggestion, or motivation for the combination of Reader and Underwood, the Section 103 rejection appears to be based on a hindsight reconstruction in which

isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 1-11 and 13-15 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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